UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,244	12/19/2000	Elizabeth Goldwyn Gibson	1906P	8208

7590 06/04/2008

SAWYER LAW GROUP LLP
PO Box 51418
Palo Alto, CA 94303

EXAMINER	
ELAHEE, MD S	

ART UNIT	PAPER NUMBER
2614	

MAIL DATE	DELIVERY MODE
06/04/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/741,244	GIBSON ET AL.	
	Examiner	Art Unit	
	MD S. ELAHEE	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 March 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed 02/26/2008. Claims 1-14 are pending.

Response to Arguments

2. Applicant's arguments filed on 02/26/2008 Remarks regarding claims 1-14 have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.

3. Applicant's arguments filed in 02/26/2008 Remarks regarding the rejection under 35 U.S.C. 112, first paragraph have been fully considered but they are not persuasive.

Regarding claims rejection under 35 U.S.C. 112, first paragraph, the Applicant argues on pages 7-8 that the claimed "three-way call" is different than a standard three-way call. However, the applicant claims that the three-way call joins three parties. From the original disclosure, it is not clear as to whether the telephone is **providing** any "three-way call" or the telephone is just outpost an ordinary call. The call will be bridged with the other two parties by the switch or the voice mailbox. Since the telephone didn't establish call path from either the calling party or the voice mailbox, there is no way for the called party's terminal to **join** the three parties.

The applicant further argues on page 8 that page 4, lines 1-19 and fig.3 support how the telephone can perform a flash-hook, which initiates a three-way call, provide a three-way call

and join the three parties. Examiner respectfully disagrees with this argument. It is because, Examiner can not match the claimed "the telephone **provides** a three-way call" to the disclosed "the telephone 100 performs a flash-hook (i.e., goes off hook), which initiates three-way call" and "When the voice mailbox 4" picks up again, the telephone **joins** the three parties". It is not clear as to whether the telephone is **providing** any "three-way call" or the telephone is just outpost an ordinary call. The call will be bridged with the other two parties by the switch or the voice mailbox. Since the telephone didn't establish call path from either the calling party or the voice mailbox, there is no way for the called party's terminal to **join** the three parties.

The applicant further argues on page 8-9 that the applicants do not understand "How can the telephone terminal join the two calls together? If the voice mailbox/switch perform the bridge, how do they know these two particular calls need to be bridged?". Examiner states that there are two different options. One is to perform bridging operation through telephone or to perform bridging operation through voice mailbox/switch. The claim would like to recite that the telephone terminal generates a second call to the voice mailbox after the first call routed to the voice mailbox. The telephone terminal joins/bridges the first call and the second call together inside the telephone terminal. However, the original specification does not teach such feature of first option because the specification fails to disclose as to how the first call is related to the telephone terminal. If the voice mailbox/switch perform the bridge, there is no support in the original disclosure for voice mailbox/switch to know these two particular calls need to be bridged.

Thus the rejection of the claims under 35 U.S.C. 112, first paragraph remain.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter i.e., the telephone provides a three-way call recited on claims 1 (lines 5-6), 5 (lines 3-4), 8 (line 5) and claim 11 (lines 4-5), which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original specification explains the invention on page 4, lines 11-18 as follows:

> Figure 4 is a flow chart which describes a voice mail screening system in accordance with the present invention. Referring to Figures 3 and 4 together, first, the called party at phone 100 sets voice mail to pick up after a predetermined number off rings, in this case, two rings, via step 302, Next, the telephone 100 performs a flash-hook (i.e., goes off hook), which initiates three-way call through line 102 of the voice mailbox 4", the called party at telephone 100 and the calling party at telephone 1" , via step 304. When the voice mailbox 4" picks up again, the telephone joins the three parties (calling party at telephone 1", voice mailbox 4", and called party at telephone 100), via step 306.

The paragraph states "Next, the telephone 100 performs a flash-hook(i.e., goes off hook), which initiates **three-way call** through line 102 of the voice mailbox 4", the called party at telephone 100 and the calling party at telephone 1" , via step 304". From this portion of the specification and applicant's arguments filed on 10/08/07, it is clear that the **three-way call** is only a regular outgoing call to the voice mailbox automatically dialed by the telephone 100. From "Newton telecom Dictionary" 19th Edition, the standard definition of Three-way call is "A local phone company feature that allows a phone user to add another user to an existing conversation and have a three party conference call". The definition states that it is the phone

company with the switching system to PROVIDE a three-way call and bridge (JOIN) three parties together in the conference call. The examiner needs clarification from the applicant about support of the definition of "Three-way call" in the original specification. It is because, the original specification fails to support such definition.

Examiner has problem to match the claimed "the telephone **provides** a three-way call" to the disclosed "the telephone 100 performs a flash-hook (i.e., goes off hook), which initiates three-way call" and "When the voice mailbox 4" picks up again, the telephone **joins** the three parties". It is not clear as to whether the telephone is **providing** any "three-way call" or the telephone is just outpost an ordinary call. The call will be bridged with the other two parties by the switch or the voice mailbox. Since the telephone didn't establish call path from either the calling party or the voice mailbox, there is no way for the called party's terminal to **join** the three parties.

The original specification fails to technologically describe as to how/when the telephone 100 automatically generate an outgoing call to the voice mailbox or the "three-way call". One of ordinary skill in the art would not be able to establish the claimed "three-way call" without undue experimentation.

Regarding the feature of bridging calls by a telephone terminal, such feature was very old (see Fuller et al. cited in Form 892). The claim would like to recite that the telephone terminal generates a second call to the voice mailbox after the first call routed to the voice mailbox. The telephone terminal joins/bridges the first call and the second call together inside the telephone terminal. However, the original specification does not teach such feature because

the specification fails to disclose as to how the first call is related to the telephone terminal. The first call never connected the telephone terminal. How can the telephone terminal join the two calls together? If the voice mailbox/switch perform the bridge, how do they know these two particular calls need to be bridged?

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-14, as best understood in light of the 35 U.S.C. 112, first paragraph rejections, are rejected under 35 U.S.C. 103(a) as being unpatentable over **Foladare** et al. (U.S. Patent 5,960,064) in view of **Rajagopalan** et al. (U.S. Pub. 2005/0084087).

Regarding claims 1, 5, 8 and 11, **Foladare** teaches a telephone system has

a switching system for receiving a call from a calling party (abstract; col.2, lines 13-16, col.8, lines 19-22) and

Foladare further teaches a voice messaging system [i.e., voice mailbox] coupled to the switching system for receiving the call if a called party does not place a return telephone call after expiration of a predetermined time period (abstract; fig.1; col.2, lines 21-23, col.8, lines 24-48). Since the called party does not return the telephone call within the predetermined time period, it is clear that the called party does not answer the call. Also, since the caller calls a personal telephone number of a called party's pager, the called party cannot answer the call. It is because, the pager can not go off-hook.

Foladare further teaches a telephone for receiving the call from the calling party, wherein the telephone provides a three-way call between the calling party, the called party, and the voice mailbox, wherein the telephone bridges the call between the calling party and the voice mailbox (col.2, lines 23-30, col.8, lines 40-57).

Foladare further teaches wherein the called party's telephone is capable of screening the calling party when the calling party is coupled to the voice mailbox (col.2, lines 23-30, col.8, lines 59-62).

However, **Foladare** does not explicitly teach wherein the telephone comprises an option key that enables a user to turn on or turn off voice mail screening.

Rajagopalan teaches wherein the telephone comprises an option key that enables a user to turn on or turn off voice mail screening (Fig.7, item 708; page 9, paragraph 0103, page 11, paragraph 0121). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate an option key that enables a user to turn on or turn off voice mail screening of **Rajagopalan** into the telephone of **Foladare** so that user can easily activate/deactivate call screening operation by pressing the call screen button.

Regarding claims 2 and 12, **Foladare** teaches that the telephone further comprises first and second connections to the switching system, wherein one of the first and second connections is utilized to provide a the three-way call (col.2, lines 23-30, col.8, lines 40-57).

Regarding claims 3, 6, 9 and 13, **Foladare** teaches that the calling party inherently cannot hear the called party during the three-way call (col.2, lines 23-30, col.8, lines 40-57).

Regarding claims 4, 7, 10 and 14, **Foladare** teaches that the called party can, through interaction with the telephone, talk with the calling party through the other of the connections and the voice mailbox is dropped from the call (col.2, lines 23-30, col.8, lines 40-57).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MD S. ELAHEE whose telephone number is (571)272-7536. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MD S ELAHEE/
MD SHAFIUL ALAM ELAHEE
Examiner
Art Unit 2614
June 4, 2008